

REMARKS

Pending claims 1-5 and 8-15 have been rejected as obvious over Onufryk (U.S. Patent No. 5,969,790), either alone or in combination with Israel (U.S. Patent No. 6,139,145), Heide et al. (U.S. Patent No. 4,575,204) or Peli et al. (U.S. Patent No. 6,775,060). These rejections are respectfully traversed for the reasons given below and reconsideration is requested. Applicant acknowledges that claim 16 has been allowed and claims 6-7 objected to.

Claims 1-5 and 10-13 have been rejected as obvious over Onufryk alone, the Examiner, among other points, saying at p. 3 that, "[a]lthough Onufryk fails to explicitly teach each image shifting element being oriented such that the optical axis of each element forms an angle between 10° and 60° relative to a horizontal visual meridian, it would have been obvious . . . to use the multiple prism designs (Figure 79) as taught by Onufryk to shift the image to a desired location."

With these comments, the Examiner both incompletely characterizes Onufryk and mischaracterizes the invention. Onufryk discloses a system comprising a prismatic lens "wherein the prisms *surround* a non prism area in an apex in, base out orientation," (col. 3, lines 34-36, emphasis added). As a consequence, the system of Onufryk teaches the use of prism elements *along and including* the horizontal visual meridian as well as above and below the horizontal visual meridian (see, e.g., Fig. 3). Furthermore, the lens elements of Onufryk are all pointing to one point at the center of the lens and, thus, each lens element must form a *different* angle relative to the horizontal visual meridian from that formed by every other lens element. In particular,

Onufryk teaches that prism above or below the pupil will point towards the pupil (vertically) and that there will be prisms lateral to the pupil, which point to the pupil (horizontally).

These teachings are in direct contrast to the limitations of the rejected claims, which require that the peripheral viewing areas *do not intersect* the horizontal visual meridian and that the optical axis of each of the plurality of image-shifting elements in a specific peripheral viewing area forms a *limited* angle (between 10° and 60°) relative to the horizontal visual meridian. In other words, in the instant invention, it is explicit that the prisms above and below the pupil (central viewing area) will point principally horizontally and that *no prism* will be lateral to the pupil. Thus, Onufryk ('790) teaches away from the Applicant's invention as recited in rejected claims 1 and 10 and the claims dependent thereon.

These physical requirements of the Applicant's system are important to the functioning of the system in performing its intended purpose. The Examiner has not indicated how someone in possession of the Onufryk system would have any idea how to modify that system to achieve the objectives of the Applicant's invention, absent hindsight use of the Applicant's disclosure.

Enclosed is a Declaration of inventor Eliezer Peli, which describes, in both words and pictorial format, the differences between the functioning of the Onufryk system and the system of the invention. As stated in the Peli Declaration at No. 13, in a comparison of the system according to the invention, a system according to Onufryk ('790) and a system as marketed by InWave Optics, Inc. for those having hemianopia, only the system according to the invention provides any help in a straight ahead

view for patients with left hemianopia. Thus, the physical differences between a system according to the teachings of Onufryk ('790) and a system having the limitations of the instant invention as claimed are important and are the causes of the indicated functional differences. The Examiner has given no indication how one of ordinary skill reading Onufryk ('790) would have any idea how to modify those teachings to achieve the invention of the instant application as claimed in claims 1-5 and 10-13 absent hindsight use of the teachings of the Applicant.

In fact, quite the opposite happened. As explained in the Peli Declaration, the company InWave Optics, Inc., has developed vision aids based on various inventions of Michael Onufryk, the inventor of the system disclosed in Onufryk ('790). This company promotes the system of Onufryk ('790) to expand the *central* field of view of patients with various vision problems, including retinitis pigmentosa (tunnel vision). For hemianopia *per se*, InWave promotes a different system, which is inferior to the system of the invention as pointed out in the Peli Declaration. The principals of InWave Optics, Inc. must be considered as those of ordinary skill in the art as they are involved in the business of correcting visual field defects (including hemianopia) with prisms. They are also well familiar with Onufryk ('790) as they licensed this patent and actually implemented and marketed the lens taught therein. Yet, for hemianopia these individuals did not offer either a variant of the Onufryk design or the design of the instant application. They offered, instead, a different design, which, as explained in the Peli Declaration, was inferior. Thus, Applicant submits that the rejection of claims 1-5 and 10-13 as obvious over Onufryk ('790) alone has been overcome.

Claim 8 has been rejected over Onufryk ('790), in view of Israel ('145); claim 9 has been rejected over Onufryk ('790), in view of Heide et al. ('204); and claims 14 and 15 have been rejected over Onufryk ('790), in view of Peli ('060). The teachings of Onufryk ('790) and its defects in making obvious the Applicant's claims have been discussed above. Applicant submits that the additionally cited references, in combination with Onufryk ('790), still cannot make obvious the indicated claims and the rejections are overcome.

Applicant submits that all claims are in condition for allowance and such action is requested.

The Examiner is encouraged to telephone the undersigned attorney to discuss any matter that would expedite allowance of the present application.

Respectfully submitted,

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